

### **REMARKS**

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

#### **I. CLAIM STATUS AND AMENDMENTS**

Claims 1-15 were pending in this application when last examined.

Claims 1-8 were examined on the merits and stand rejected.

Claim 9-15 were withdrawn as non-elected subject matter. Applicants reserve the right to file a continuation or divisional application on any withdrawn subject matter.

Claims 1, 2, 5, 6 and 8 are amended.

Support for the amendment to claim 1 can be found on page 1, lines 24-29 of the specification and in claim 4 as filed. Claim 2 is amended to delete non-elected subject matter without prejudice thereto. Support for the amendment to claim 5 can be found in claim 5 as filed. Claims 6 and 8 are amended to correct informalities.

Claims 3 and 4 as well as withdrawn claims 9-15 are cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

No new matter has been added.

Applicants further note priority under 35 U.S.C. § 119 was not acknowledged on page 1 of the Office Action. Acknowledgement of such is respectfully requested.

#### **II. CLAIM OBJECTION**

In item 5 on pages 2-3 of the Office Action, claims 1, 2, 3 and 5 were objected to for reciting subject matter drawn to non-elected inventions. Further, claims 6 and 8 were objected to for being in improper form since they depended upon multiply dependent claims. These objections are overcome for reasons which are self-evident.

### **III. INDEFINITENESS REJECTION**

In item 6 on page 3 of the Office Action, claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for the term “ $\Delta$ NBax”. Applicants respectfully traverse this rejection as applied to the amended claims.

Applicants note that amended claim 1 recites that the  $\Delta$ NBax protein comprises an amino acid sequence from the 112<sup>th</sup> to the 192<sup>nd</sup> of human Bax of the amino acid sequence of SEQ ID NO: 2. Further,  $\Delta$ NBax is defined by function. Thus, this rejection is overcome.

### **IV. ENABLEMENT REJECTION**

In item 7 on pages 3-5 of the Office Action, claims 1-8 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse this rejection as applied to the amended claims.

Applicants note that on page 7, lines 15-25,  $\Delta$ NBax is fully defined by amino acid residues 112-192 of SEQ ID NO: 2. Therefore, there is no missing essential material from the specification. It is therefore irrelevant that  $\Delta$ NBax is also referred to by reference to a publication as the information in this publication is not necessary for a person of skill in the art to understand the sequence of  $\Delta$ NBax.

Thus, for the above-noted reasons, Applicants suggest that this rejection is untenable and should be withdrawn.

### **V. WRITTEN DESCRIPTION REJECTION**

In item 8 on pages 5-9 of the Office Action, claims 1-4 and 6-8 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse this rejection as applied to the amended claims.

In particular, the Examiner rejected the term “ $\Delta$ NBax” as not being adequately supported by the specification. Applicants note that the term “ $\Delta$ NBax” has been amended without acquiescence to the correctness of this rejection in order to recite a particular SEQ ID NO. Further, the Examiner was concerned that there was lack of support for sequences encompassed by sequences which are “complimentary” to a DNA hybridizing to a sequence of DNA as set forth in SEQ ID NO: 3. Without acquiescence to the correctness of this rejection, and in

conformance with the Examiner's suggestion in the rejection, the claims have been amended to recite "completely complimentary to". Thus, this rejection is overcome.

## **VI. OBVIOUSNESS REJECTION**

In item 12 on pages 10-11, Claims 1-4 and 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aokage et al. (Biochem Biophys Res Commun. 2004; 341(3):771-716) and Ellerby et al. (Nature Medicine 1999; 5(9):1032-1038) or U.S. Patent 6,576,239 (Ruoslahti et al.) in view of Ishibashi et al. (Biochem Biophys Res Commun. 1998 Feb 13; 243 (2):609-616) and Usui et al. (Oncogene 2003; 22:2655-2663). Applicants respectfully traverse this rejection as applied to the amended claims.

Aokage et al. was published in November, 2004. On the other hand, the priority date of the present application is March 24, 2003, which is prior to the publication date of Aokage et al.

A copy of the priority documents was forwarded to the USPTO as indicated in the Notice of Acceptance of Application Under 35 U.S.C. § 371 and 37 C.F.R. 1.495 mailed July 18, 2006. Attached to this reply is a verified translation of Japanese Patent Application No. 2003-18337 filed on March 24, 2003. This certified translation and therefore the priority document supports the pending claims. Thus, Aokage et al. cannot be properly applied as prior art.

Applicants further note that submission of references in an IDS is not an admission that such references are prior art.

The Examiner contends that Aokage et al. teaches a gene comprising GFP fused to the Bax gene. The Examiner, however, does not indicate that any other of the above-noted references recite the GFP fusion of the claimed invention. Thus, the noted references in the absence of Aokage et al. fail to teach or suggest each and every element of the claimed invention. Therefore, this rejection is untenable and should be withdrawn.


**CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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